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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,997	02/24/2004	Roger D. Tung	VPI9207C2AD3	9030
1473	7590	09/22/2004	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			SEAMAN, D MARGARET M	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/786,997

Applicant(s)

TUNG ET AL.

Examiner

D. Margaret Seaman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### DETAILED ACTION

This application was filed 2-24-04 and is a CON of 10/094763 (US Patent #6,720,335) which is a DIV of 09/409808 (6392046) which is a DIV of 09/115394 (5977137) which is a DIV of 09/393460 (5783701) which is a CIP of 08/142327 (5585397) which is a CIP of 07/941982 (ABN). Claims 1-27 are before the Examiner and are subject to the following election/restriction requirement.

#### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12 ( in part), drawn to compounds of claim 1 wherein A is H, classified in various classes and subclasses, depending upon a single elected disclosed species.
  - II. Claims 1-12 ( in part), drawn to compounds of claim 1 wherein A is het or R1-het and het is cycloalkyl, classified in various classes and subclasses, depending upon a single elected disclosed species.
  - III. Claims 1-12 ( in part), drawn to compounds of claim 1 wherein A is het or R1-het and het is cycloalkenyl, classified in various classes and subclasses, depending upon a single elected disclosed species.
  - IV. Claims 1-12 ( in part), drawn to compounds of claim 1 wherein A is het or R1-het and het is aryl, classified in various classes and subclasses, depending upon a single elected disclosed species.

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- V. Claims 1-12 ( in part), drawn to compounds of claim 1 wherein A is het or R1-het and het is a 5-7 membered ring with only N as hetero atoms, classified in various classes and subclasses, depending upon a single elected disclosed species.
- VI. Claims 1-12 ( in part), drawn to compounds of claim 1 wherein A is het or R1-het and het is a 5-7 membered ring with only O/S as hetero atoms, classified in various classes and subclasses, depending upon a single elected disclosed species.
- VII. Claims 1-12 ( in part), drawn to compounds of claim 1 wherein A is het or R1-het and het is a 5-7 membered ring with both N and O/S as heteroatoms, classified in various classes and subclasses, depending upon a single elected disclosed species.
- VIII. Claims 1-12 ( in part), drawn to compounds of claim 1 wherein A is R1-alkyl, classified in various classes and subclasses, depending upon a single elected disclosed species.
- IX. Claims 13-15, drawn to compounds, classified in various classes and subclasses, depending upon a single elected disclosed species.
- X. Claims 16-17, drawn to a pharmaceutical composition, limited to one of groups I-IX, classified in class 514, subclass various, depending upon a single disclosed elected species.

- XI. Claims 18-19, drawn to a method of treating a viral infection, limited to one of groups I-X, classified in class 514, subclass various, depending upon a single disclosed elected species.
- XII. Claims 20-21, drawn to a method of inhibiting enzymatic activity, limited to one of groups I-X, classified in class 514, subclass various, depending upon a single disclosed elected species.
- XIII. Claims 22 and 24 (in part), drawn to a method of preventing HIV infection, limited to one of groups I-X, classified in class 514, subclass various, depending upon a single disclosed elected species.
- XIV. Claims 23 and 24 (in part), drawn to a method of treating HIV infection, limited to one of groups I-X, classified in class 514, subclass various, depending upon a single disclosed elected species.
- XV. Claims 25-27, drawn to a method of identifying compounds, classified in various classes and subclasses, depending upon a single disclosed elected species.

2. The inventions are distinct, each from the other because of the following reasons:

Unpatentability of the group I compounds would not necessarily imply unpatentability of the group II-IX compounds because the compounds are so divergent that a reference providing a 35 U.S.C. §102(b) rejection on a member of one group would not render a member of the other groups obvious under 35 U.S.C. §103.

Unpatentability of the group X pharmaceutical compositions would not necessarily imply unpatentability of the group XI pharmaceutical compositions because the compounds are so divergent that a reference providing a 35 U.S.C. §102(b) rejection

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on a member of one group would not render a member of the other groups obvious under 35 U.S.C. §103.

Unpatentability of the group XI methods would not necessarily imply unpatentability of the group XII-XV methods because the compounds are so divergent that a reference providing a 35 U.S.C. §102(b) rejection on a member of one group would not render a member of the other groups obvious under 35 U.S.C. §103.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.


4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 571-272-0694. The examiner can normally be reached on 630am-4pm, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecelia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
D. Margaret Seaman  
Primary Examiner  
Art Unit 1625

dms